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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,439	08/20/2003	Curtis R. Richardson	OTTR.01USC1	7991

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EXAMINER

EDWARDS, ANTHONY Q

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,439

Applicant(s)

RICHARDSON, CURTIS R.

Examiner

Anthony Q. Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Objections***

Claims 11-15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 11 recites “the protective cover of claim 11”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 8-10 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,415,138 to Sirola et al. (hereinafter “Sirola”). Referring to claim 1, Sirola discloses a protective membrane (5) for a touch screen (3) comprising a recessed area (5a) disposed over said touch screen, said recessed area being at least partially transparent (see col. 5, lines 2-4), a surface finish having a predetermined smoothness, said recessed area having a predetermined thickness, said recessed area having a predetermined stiffness (see col. 3, lines 24-

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29, and 48-52), said predetermined smoothness, said predetermined thickness, and said predetermined stiffness being selected such that simultaneous pressing and sliding of a stylus over said recessed area creates a tactile input to said touch screen (see col. 4, lines 1-10).

Referring to claim 2, Sirola discloses a protective membrane (5) further comprising a peripheral mounting mechanism (4a) whereby said protective membrane may be mounted in a case (4). See Fig. 3 and col. 6, lines 35-37.

Referring to claim 3, Sirola discloses a protective membrane (5) further comprising printing on said recessed area. See col. 6, lines 58-60.

Referring to claim 8, Sirola discloses a protective cover (see Figs. 1 and 2) that protects a touch screen (3) on an electronic device (1) and allows sliding tactile input to the touch screen (see col. 4, lines 3-10) comprising a protective enclosure or housing (2) that attaches to the electronic device (1), a protective membrane (5) that is attached to the protective enclosure (2) comprising a recessed area (5a) disposed over said touch screen, said recessed area being at least partially transparent (see col. 5, lines 2-4), said recessed area having a surface finish with a predetermined smoothness, said recessed area having a predetermined thickness, said recessed area having a predetermined stiffness (see col. 3, lines 24-29, and 48-52), said predetermined smoothness, said predetermined thickness, and said predetermined stiffness being selected such that simultaneous pressing and sliding of a stylus over said recessed area is sufficient to create a tactile input to said touch screen (see col. 4, lines 1-10).

Referring to claim 9, Sirola implicitly teaches a protective cover, wherein the protective enclosure (2) attaches to the device (1) by enveloping the device. See Figs. 1 and 2.

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Referring to claim 10, Sirola implicitly teaches a protective cover, wherein the protective enclosure covers an exterior portion of the device.

Referring to claims 7 and 16, Sirola discloses a protective membrane (5), wherein at least the recessed area is manufactured using ejection molding. See col. 6, lines 41-44 of Sirola.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirola in view of U.S. Patent No. 6,471,056 to Tzeng. Referring to claim 4, Sirola discloses the protective membrane as claimed, except for the recessed area being manufactured from polyvinylchloride (PVC). Tzeng discloses a portable electronic device protective cover (7) for touch screen devices (8) in which the area of the protective device (72) covering the touch screen is a transparent PVC sheet material. See Fig. 7 and col. 2, lines 22-25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the protective membrane of Sirola to provide a transparent PVC sheet material, as taught by Tzeng to reduce the cost of manufacture while still meeting desired usability tolerances for the protective cover.

Referring to claim 5, Sirola in view of Tzeng disclose a protective membrane as claimed, since even though the claims are limited by and defined by the recited process, the determination of patentability of the product is based on the product itself, and does not depend on its method

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of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by the different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Referring to claim 6, Sirola in view of Tzeng disclose a protective membrane having a thickness within the claimed range (i.e., 0.010 inches to 0.015 inches). See col. 5., lines 11-12 of Sirola, which discloses a lower limit of 0.012 inches (i.e., 0.3 mm) for the thickness of the membrane.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirola in view of U.S. Patent No. 6,094,785 to Montgomery et al. Referring to claim 11, as best understood by the Examiner, Sirola discloses the protective cover as claimed, except wherein the protective enclosure (2) snaps into the exterior portion of the device (1). Montgomery et al. disclose an apparatus having snap retention devices (202-207) for combining electronic device housings (100). See Figs. 2, 4 and the corresponding specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the protective cover of Sirola to include snap retention devices, as taught by Montgomery et al. to provide greater tamper resistance for the protective cover of Sirola, while still allowing for removal of the cover for maintenance purposes.

Referring to claim 12, as best understood by the Examiner, Sirola in view of Montgomery et al. disclose the protective as claimed, further comprising printing on the recessed area (5a). See col. 6, lines 58-60.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sirola in view of Montgomery et al., and further in view of Tzeng. Referring to claim 13, as best

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understood by the Examiner, Sirola as modified, in view of Tzeng disclose the protective membrane wherein the recessed area is manufactured from polyvinylchloride (PVC).

Referring to claim 14, as best understood by the Examiner, Sirola as modified, in view of Tzeng disclose the protective membrane as claimed, since even though the claims are limited by and defined by the recited process, the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by the different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Referring to claim 15, as best understood by the Examiner, Sirola as modified, in view of Tzeng disclose the protective membrane as claimed. See col. 5., lines 11-12 of Sirola, which discloses a lower limit of 0.012 inches (i.e., 0.3 mm) for the thickness of the membrane that is within the as claimed range.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 6,665,174 to Derr et al. disclose a portable electrical control and display device having a single-piece housing made of temperature resistant, water tight material.

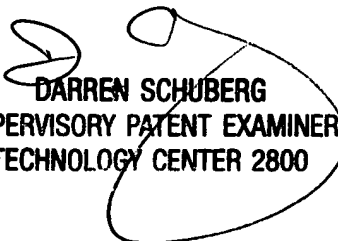
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Q. Edwards whose telephone number is 571-272-2042. The examiner can normally be reached on M-F (7:30-3:00) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 29, 2004
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